

REMARKS

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected and remain pending. Claims 2-4, 6, 9, 13-16, 19, and 22-27 were canceled in previous responses. Claims 1, 5, 7, 8, 11, 12, 17, 18, 20, and 21 were previously amended. No claims are amended herein. Applicant respectfully requests consideration of the following remarks and allowance of the claims.

35 U.S.C. § 103 Rejection

Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,718,551 (Swix) in view of U.S. Patent No. 5,822,018 (Farmer) in view of U.S. Patent No. 6,698,020 (Zigmond) in view of “NDS:NDS’XTV™ time shifting technology empowers the viewer and the broadcaster,” M2 Presswire, September 10, 1999, (XTV), and further in view of U.S. Patent No. 6,588,015 (Eyer). Applicant respectfully traverses the rejection because the Office action does not address all the limitations of the claims, the cited references do not teach all the limitations claimed, and because the cited references are mischaracterized.

The Office action does not address the limitation of claim 1 which recites *determining an insertion point in the selected video content for the selected video advertising, wherein the insertion point comprises data indicating where in the selected video content the selected video advertising is to be inserted.* The Office action skips this limitation and does not indicate where it is taught within the cited references (Office action, page 2, last para.).

The cited references fail to teach *transferring the selected video content to a target viewer device over a first transport system and transferring the selected video advertising to the target viewer device over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system and transferring the insertion point to the target viewer device over the second transport system* as recited in claim 1. The Office action asserts these limitations are taught by a combination of Swix and Farmer (Office action, page 3, lines 1-9). However, this assertion is a mischaracterization of those references in several respects.

The Office action asserts that the combination of Swix and Farmer teaches *transferring the selected video content to a target viewer device over a first transport system and transferring the insertion point to the target viewer device over the second transport system* (page 2, last para. – page 3, first para.). It is unclear exactly which of these elements is purportedly taught by each of the two references. However, it is a mischaracterization in either case because Swix and Farmer, individually and in combination, fail to teach transferring a video advertisement insertion point over a second transport system.

In Swix, the beginning of an insertion slot for a targeted advertisement is indicated by the head end using a “q-tone” (Swix, col. 13, lines 15-17). At the q-tone, the head end communicates to “each set-top box 1) which PID to tune to, and 2) for how long” (Swix, col. 13, lines 24-28). The set-top box, or target viewer device, receives no information referencing a *location* in the video content where the advertisement will be inserted; it simply receives a real time command to immediately change to another channel. Swix also teaches that the head end manages the advertisement insertion process for all set-top boxes and is responsible for real time communication to each set-top box each time tuning to a different channel is required (Swix, col. 13, lines 24-33). Thus, Swix does not teach use of an *insertion point* which is *transferred* to the target viewer device *over a second transport system* as recited in claim 1. In fact, attempting to do so within the Swix system would be illogical because the Swix system commands the set-top boxes to switch from video content to advertising content on a real time basis.

It is also a mischaracterization to suggest that Farmer teaches transferring the video content and an insertion point to the target device over a separate transport system (Office action, page 3, lines 6-9). Farmer does not teach two transport systems which separately transport these two pieces of data to a single target device as recited in claim 1. Farmer teaches a single device which transfers cue tones and program material to two separate locations (Farmer, fig. 1). The earth station receiver transfers cue tones to the ad-insertion system over link 23 and transfers program material to a switch and a modulator over link 22 (Farmer, fig. 1). Farmer does not teach transferring the selected video content *and* an insertion point to a single device, *a target viewer device*, over

separate transport systems as recited in claim 1. In other words, links 22 and 23 in Farmer do not terminate in the same device.

Therefore, it is a mischaracterization to suggest that Swix and Farmer, either individually or in combination, teach *transferring the selected video content to a target viewer device over a first transport system and transferring the insertion point to the target viewer device over the second transport system*. In addition, Swix and Farmer, individually and in combination, do not disclose operating a system which performs these functions using a *first transport system which uses greater bandwidth . . . than the second transport system* as recited in claim 1.

Zigmond neither addresses the limitations discussed above nor makes them obvious. In Zigmond, the home entertainment system does not receive information about where advertisements will be inserted relative to the video content. Like Swix, the entertainment system of Zigmond simply waits for a trigger signal and immediately switches to a different video source in response to that trigger signal without any reference to how that switch relates to the video content (Zigmond, fig. 6). Thus, Zigmond does not teach use of an *insertion point* or transfer *over a second transport system* as recited in claim 1.

XTV and Eyer relate generally to methods of prohibiting viewers from skipping advertisements and do not address the limitations of claim 1 discussed above.

Therefore, for at least the reasons discussed above, Applicant contends that independent claim 1 is allowable in view of the combination of Swix, Farmer, Zigmond, XTV, and Eyer, and such indication is respectfully requested.

Independent claim 12 contains limitations similar to those described above with respect to claim 1, and is therefore allowable over the art of record for at least the same reasons as claim 1.

Dependent claims 7, 8, 11, 17, 18, and 21 are referenced generally in the text of the Office action (page 1, last para.). However, the specific limitations of these claims are not discussed and no explanation is given for the rejection of these claims.

Claims 5, 7, 8, 10, 11, 17, 18, 20, and 21, while separately allowable over the art of record, depend from otherwise allowable independent claims 1 and 12. Applicant

therefore refrains from further discussion of these dependent claims for the sake of brevity.

Therefore, in light of the discussion above, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21.

CONCLUSION

Based on remarks above, Applicant submits that the claims in their present form are allowable over the art of record. Additional reasons in support of patentability exist, but such reasons are omitted in the interests of clarity and brevity. Applicant respectfully requests allowance of the claims at the Examiner's earliest convenience. If the claims are not allowed, Applicant respectfully requests that the next Office action be non-final in light of the comments above.

Applicant believes no fees are due with respect to this filing. However, should the Office determine that fees are necessary, the Office is hereby authorized to charge Deposit Account No. 21-0765 accordingly.

Respectfully submitted,

/Todd C. Adelmann/

SIGNATURE OF PRACTITIONER

Todd C. Adelmann, Reg. No. 55,827
Setter Roche LLP
Telephone: (720) 562-2280
E-mail: todd@setterroche.com

Correspondence address:

CUSTOMER NO. 28004

Attn: Melissa A. Jobe
Sprint
6391 Sprint Parkway
Mailstop: KSOPHT0101-Z2100
Overland Park, KS 66251-2100